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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,856	11/01/2001	Quynh T. Pham	J6655(C)	9814

201 7590 12/30/2004

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EXAMINER
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FUBARA, BLESSING M

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/044,856

Applicant(s)

PHAM ET AL.

Examiner

Blessing M. Fubara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-8 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8 and 10-14 is/are allowed.
- 6) ☒ Claim(s) 1, 3-7 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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### DETAILED ACTION

Examiner acknowledges receipt of amendment and remarks filed 09/16/04. Claims 1, 3-8, 10-14 and new claim 15 are pending.

#### *Claim Rejections - 35 USC § 103*

1. Claims 1, 2-7 and new claim 15 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Beerse et al. (US 6,294,186).

Applicants state the following:

Glycerol and sorbitol moisturizing humectants are concentration dependent and formulations having the moisturizing humectants (glycerol or sorbitol) at concentration of about 10% confer sticky, tacky feeling. Applicants further state that because of the sensory effects conferred on a target area by the humectants, formulations containing higher levels of humectants are not commercially acceptable. Applicants point to the Wetting Test data in Tables A and B where PEMULEN TR-2 forms a uniform film, and CARBOPOL 981 does not.

Applicants then argue that there is no obviousness under 35 USC over Beerse ((US 6,294,186) because the composition of Beerse discloses antimicrobial composition that contains benzoic acid and that Beerse does not disclose the selection of PEMULEN TR-2 over PEMULEN TR-1 since the instant specification teaches the CARBOPOL 981 and PEMULEN TR-1 do not meet the Wetting Test and since examples 14 and 15 discloses compositions that contain PEMULEN TR-1 and CARBOPOL; and that the selection of PEMULEN TR-2 is critical to the instant invention "as shown by the objective evidence presented in the specification."

Applicants further argue that the disclosure of Beerse is extremely broad covering products from personal care to household care so that the disclosure of Beerse would not lead a

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skilled artisan to select a composition that has the “essential elements in the particular combination.” Applicants further argue that thickening agents including PEMULEN and CARBOPOL, and silicone elastomers are optional in Beerse and thus the office action improperly picked and chose aspects of the prior art reference without showing motivation to combine them. Furthermore, applicants argue that claim 8 excludes additional component such as benzoic acid and that the prior art does not disclose the claimed invention as a whole.

***Response to Arguments***

2. Applicants' arguments, see page 9 of the remarks, filed 09/16/04, with respect to claims 8 and 10-14 have been fully considered and are persuasive. The rejection of claims 8 and 10-14 over Beerse et al. (US 6,294,186) has been withdrawn.

3. Applicants' arguments filed 09/16/04 have been fully considered but they are not persuasive.

Claim 1 does not exclude antimicrobial agents since the composition in claim 1 comprises.... The instant claims do not specifically claim PEMULEN TR-2 and although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicants admit that Beerse discloses PEMULEN TR-2 and because Beerse discloses that PEMULEN can be used in the composition, a composition that contains or may contain PEMULEN TR-2 is disclosed and the prior art does not have to exemplify all the variations of disclosed composition. Thus, the fact that Beerse exemplifies a composition that contains PEMULEN TR-1 does not exclude the disclosure in Beerse that PEMULEN TR-2 can be used in

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the composition and this disclosure is a disclosure and suggestion for a composition that comprises PEMULEN TR-2. Although, applicants insist that PEMULEN and CARBOPOL are optional in Beerse, it is respectfully noted that optional ingredients in the composition of the prior art is a disclosure for a composition that contains or would contain those optional ingredients and by this applicants admit of a composition in Beerse that contains PEMULEN or CARBOPOL. It is also noted that the CARBOPOL disclosed in Beerse is CARBOPOL 1342 and CARBOPOL 1382, Beerse does not disclose CARBOPOL 981, which applicants say does not meet the Wetting Test. Applicants' argument that Beerse broadly discloses products that can be used in personal care to household care is argument for the intended use of a composition and a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). There is no structural difference between the composition of the prior art and the instant composition.

Claims 8 and 10-14 are allowable over the prior art because Beerse discloses a composition that contains benzoic acid.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bf

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